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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,413	12/17/2003	Ralph R. Binetti	SC66U-US	8915
60723	7590	08/28/2006	EXAMINER	
AVON PRODUCTS, INC. AVON PLACE SUFFERN, NY 10901			BOWMAN, AMY HUDSON	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

HJ

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/738,413	BINETTI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Amy H. Bowman	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 June 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.  
 4a) Of the above claim(s) 40 and 41 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 1-39 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Election/Restrictions***

This is a supplemental restriction requirement based on applicant's preliminary amendment filed after election.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-39, Claims 1-15, drawn to a method comprising administering a composition comprising one or more siRNA oligomers specific for **mouse** tyrosinase mRNA in an effective amount to prevent, ameliorate, reduce, and/or eliminate the unwanted skin condition, classified in class 514, subclass 44.
- II. Claims 1-39, Claims 1-15, drawn to a method comprising administering a composition comprising one or more siRNA oligomers specific for **human** tyrosinase mRNA in an effective amount to prevent, ameliorate, reduce, and/or eliminate the unwanted skin condition, classified in class 514, subclass 44.

The inventions of groups I and II are directed to related methods. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the methods have materially different effects depending on the target

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sequence. The method of group I is drawn to administering siRNA oligomers specific for mouse tyrosinase mRNA, whereas the invention of group II is drawn to administering siRNA oligomers specific for human tyrosinase mRNA.

Although each of the target sequences comprise nucleotides, it is the sequence of such nucleotides which defines specific siRNA oligomers targeted to each specific sequence. Furthermore, a search of more than one of the sequences claimed presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one of the claimed sequences.

Although the literal meaning of the claim amendment reciting "mouse and human tyrosinase mRNA" would have one believe that the siRNA oligomers are targeted to both mouse and human, the instant specification does not offer support for siRNA oligomers ~~that specifically target~~<sup>capable of</sup> ~~and selectively~~<sup>both</sup> <sup>a single</sup> <sup>simultaneously</sup> tyrosinase mRNA. Therefore, the claim language is being interpreted as siRNA oligomers specific for mouse or human tyrosinase and therefore restriction is proper.

If it is indeed applicant's intention to claim a method of administering those siRNA oligomers that are specific for both mouse and human tyrosinase mRNA, applicant is encouraged to point out with particularity by page and line number where such support might exist. In applicant's argument's filed 6/2/2006, applicant points to page 7 for support for siRNA sequences that recognize both human and mouse mRNA encoding tyrosinase. However, the siRNA sequences on page 7 of the instant specification are specifically disclosed as being human sequences.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy H. Bowman whose telephone number is 571-272-0755.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It

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also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Amy H. Bowman  
Examiner  
Art Unit 1635

  
JAMES SCHULTZ, PH.D.  
PRIMARY EXAMINER